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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,347	09/13/2004	Diane L. Lawson	labeltape	5346
23217	7590	08/18/2005	EXAMINER DESAI, ANISH P	
GLENN L. WEBB P.O BOX 951 CONIFER, CO 80433			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/711,347

Applicant(s)

LAWSON, DIANE L.

Examiner

Anish Desai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to adhesive packaging tape, classified in class 428, subclass 343.
- II. Claims 9-16, drawn to a method of applying adhesive tape to a container, classified in class 53, subclass 415.

The inventions are distinct, each from the other because:

1. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different product such as a product that does not require the use of an adhesive backing, but instead could utilize a heat shrinking process to seal the tape onto the container. Alternatively, the product as claimed can be used in a materially different process of using that product such as a process that use of stacked supply of tape, which is "zig zag", folded instead of being supplied in a roll.
2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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3. During a telephone conversation with Glenn Webb on 7/6/2005 provisional election was made without traverse to prosecute the invention of the adhesive tape, claims 1-8. Affirmation of this election must be made by applicant in replying to this Office action. Claims 9-16 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Wu (US Patent 4,587,156).

5. Wu teaches a pressure sensitive adhesive (PSA) tape used as a high performance packaging and identification tape (Column 2, lines 66-67). Wu's tape has a backing with a PSA layer on the one surface of the backing and the other surface, which can be printed (column 3, lines 11-16). The printed tape of Wu can be used as a packaging or holding tape as well as a printed identification of instructed message (Column 3, lines 7-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu (US Patent 4,587,156) in view of Scotch® Printed Message Tapes (3M Company).
7. The invention of Wu is previously disclosed. Wu is silent with respect to teaching the printed text repeated at intervals, color coding, color coding and printed text indicating the identity of the contents of the container, indicia indicating the identity of a room, first and second indicia, and a writable portion as claimed in claims 3-8 respectively.
8. The Scotch® Printed Message Tapes by the 3M company sold as packaging tapes shows a printed message printed on the tape (see Technical Data and the picture). The various printed messages such as "FRAGILE", "HANDLE WITH CARE", and "RUSH" are repeated at regular intervals.
9. Additionally, note that the picture also shows, color coding such as two upside arrows and printed text (e.g. THIS SIDE UP). Regarding, the claims 6 and 7, although the picture of Scotch® Printed Message Tapes does not explicitly show the indicia indicating the identity of a room as claimed in the claim 6 and the second indicia indicating the identity of different contents of other

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containers as claimed in the claim 7, it is obvious that the skilled artisan can choose to print any type of indicia according to the desired use because the Scotch® Printed Message Tapes are printable. Also note regarding the claims 4-7, the printed matters such as the indicia and the color coding claimed by the applicant is not functionally related to the substrate. Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability (see MPEP 2112 and *in re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983).

10. Regarding the claim 8, note that it is obvious that one can write on the space between the text messages "RUSH" or "MIXED MERCHANDISED ENCLOSED" on the Scotch® Printed Message Tapes (see picture).

11. Regarding the claims 3-8, a skilled artisan would have found it obvious to print a text at repeated interval, use a color coding and printed text indicating the identity of the contents, indicia, and having a writable portion on the tape as disclosed in the Scotch® Printed Message Tapes and used it in the invention of WU. One would be motivated to do this, in order to provide a packaging and identification tape.

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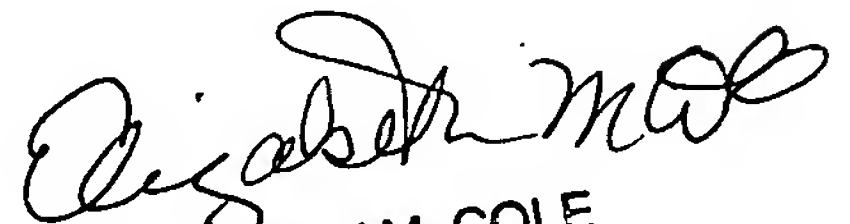
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APD


ELIZABETH M. COLE
PRIMARY EXAMINER